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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,362	09/30/2003	Charles F. Duggan	P0885D	3232

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DIGIMARC CORPORATION
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EXAMINER	
WHIPKEY, JASON T	
ART UNIT	**PAPER NUMBER**
2622	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/676,362	DUGGAN ET AL.	
	Examiner	Art Unit	
	Jason T. Whipkey	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 12, 2006, have been fully considered but they are not persuasive.

Regarding **claims 1 and 9**, Applicant first argues that Bley and Fujino do not suggest a computer integrated into a camera stand of a capture station. However, Bley discloses this, without regard to the teachings of Fujino. Figure 1 shows a schematic view of Figure 2A, which includes a stand (housing 40) holding a camera (12). The stand includes a processing module 11, comprised of RAM, disk drives, a CPU, and connections to peripherals. This certainly qualifies as a computer.

Applicant argues, "While Fujino teaches a networked camera, Bley teaches away from integrating a networked camera into a capture station because it teaches a photo ID production system that is intended to be self-contained and is not intended to be operated under the control of a remote workstation." This assertion is incorrect.

Bley's device has a LAN connection 35, indicating that it can connect to a network and is therefore not entirely self-contained. However, assuming *arguendo* that Bley's device is self-contained, the teachings of Fujino applied to Bley would result in an additional benefit — namely, allowing multiple users to access the camera — without rendering Bley's device inoperable or unfit for its intended purpose. This situation is analogous to a desktop personal computer. Since a PC is capable of operating on its own, it is self-contained, but a PC can

additionally be connected to a local area network, thereby extending its functionality while not sacrificing its ability to operate independently.

Applicant argues that paragraph 9 of Fujino "highlights problems associated with attempting to share a camera, and therefore, does not provide adequate teaching to one of skill in the art to lead him or her to modify the teachings of Bley to include the claimed network interface program and camera control program." While Fujino discloses problems that may result from sharing a camera, he also discloses benefits. Any engineering design choice will necessarily involve positives and negatives. The advantage Fujino presents would lead one of ordinary skill in the art to consider modifying the teachings of Bley, despite the limitations also presented.

Applicant also asserts that "the Office contends that these elements are merely inherent in the cited art, which further detracts from the adequacy of the teachings of Bley and Fujino and the motivation to combine them." As stated in the original rejection, the only element that is inherently present is a network interface program *per se*, which must be present in order to implement the TCP/IP protocol. All other limitations — including the transfer of camera control commands and image data — are explicitly cited, particularly in paragraphs 36-39 of Fujino.

Regarding **claim 2**, Applicant argued that the Official Notice needs further substantiation. In the rejection below, the Official Notice has been replaced with a reference.

Regarding **claim 13**, the examiner agrees that none of the cited references teach the camera stand having a base and slidably attached tower, along with a computer integrated into the base. However, Bley discloses a camera stand (system 10) having a base (housing 40), wherein a computer (processing module 11) is integrated into the base. However, as presented

on page 10 of the rejection, Official Notice is taken that it is well known in the art to have camera supports of adjustable height.

Double Patenting

2. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16 and 19 of copending Application No. 11/112,965. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 is a broader recitation of the invention claimed in claims 16 and 19 of the '965 application. Therefore, claim 1 is encompassed by claims 16 and 19. A terminal disclaimer is necessary so as to ensure that any two resulting patents are commonly owned throughout their lifetimes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bley (U.S. Patent No. 6,038,012) in view of Fujino (U.S. Patent Application Publication No. 2002/0191082).

Regarding **claim 1**, Bley discloses an all in one capture station (see Figure 2A) for creating identification documents comprising (see column 2, lines 22-25):

a camera stand (housing 40);

a camera (12) mounted within the camera stand;

a computer (processing module 11) integrated into the camera stand; the computer including a processor (CPU 20), network interface device (interface port 26; see column 3, lines 2-5), and memory (RAM 21), the memory storing a camera control program (in order to carry out the steps described in column 4, lines 13-65, it is inherent that some sort of software is present) to capture data for incorporation into an identification document (see column 4, lines 41-67).

Bley is silent with regard to including a network interface program for transferring camera control commands and image data between the capture station and a remote workstation.

Fujino discloses a camera system, including:

> a network interface program (inherently present, as it implements the TCP/IP protocol; see paragraph 31) for transferring camera control commands and image data between the capture station and a remote workstation such that the capture station operates under the control of the remote workstation (see paragraphs 36-39).

As stated in paragraph 9, an advantage of making a camera available through a network is that multiple people can use a single camera. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's capture station accessible by a network.

Regarding **claim 5**, Fujino discloses:

> the computer operates in standby mode such that the computer is controllable from the remote workstation without requiring an operator to log on to the computer in the station (control is performed via web server 22; see paragraph 34).

Regarding **claim 6**, Fujino discloses:

> the camera control program is implemented as a web server (22) and is controllable via a web page (rendered by web browser 3) executing on a remote, client workstation (PC; see Figure 1 and paragraph 34).

Regarding **claim 7**, Fujino discloses:

the computer and camera in the station are shared by two or more workstations that control the station remotely through a network connection established with the network interface program (see paragraph 9).

Regarding **claim 8**, Bley discloses:

the station includes a video device interface for a video display (monitor 41) and an input device interface (keyboard 30) for enabling an operator to enter alphanumeric input, and the station has a stand alone mode control mode in which data capture for identification document creation is controlled locally (see column 4, lines 23-67).

Bley is silent with regard to including a remote control mode. Fujino discloses:

a remote control mode in which data capture for identification document creation is controlled from the remote workstation (see paragraphs 9 and 34).

As stated in paragraph 9, an advantage of making a camera available through a network is that multiple people can use a single camera. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's capture station accessible by a network.

Regarding **claim 9**, Bley discloses a method for creating an identification document comprising:

presenting a user interface that enables an operator to enter applicant data and control capture of image information for incorporation into an identification document (see column 4, lines 23-39);

in an all in one capture station having a camera stand (housing 40), a camera (12) mounted within the camera stand, and a computer (processing module 11) integrated into the camera stand; the computer including a processor (CPU 20), network interface device (interface port 26; see column 3, lines 2-5), and memory (RAM 21), executing a camera control program that controls the camera (in order to carry out the steps described in column 4, lines 13-65, it is inherent that some sort of software is present), and

using a captured image along with other information obtained at the first computer workstation to create an electronic image for printing on an identification document (see column 4, lines 41-67).

Bley is silent with regard to including a network interface program for transferring camera control commands and image data between the capture station and a remote workstation.

Fujino discloses a camera system, including:

a network interface program (inherently present, as it implements the TCP/IP protocol; see paragraph 31) for receiving camera commands through the network interface device (see paragraphs 36-39);

setting up a network connection between a first computer workstation and the computer in the all in one capture station (see *id.*);

in response to an operator command to capture an image entered in the user interface, sending a camera control command to the camera control program in the all in one capture station through the network connection (see *id.*);

receiving a captured image in the first computer workstation in response to the camera control command (see paragraphs 38 and 39).

As stated in paragraph 9, an advantage of making a camera available through a network is that multiple people can use a single camera. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's capture station accessible by a network.

Regarding **claim 10**, Bley discloses:

the all in one capture station controls one or more additional biometric capture devices (signature digitizer pad 32 and fingerprint digitizer pad 33) to capture biometric information used in an identification document enrollment process.

Bley is silent with regard to controlling the station remotely.

Fujino discloses:

devices that are controllable via network connections from one or more other computer workstations (see paragraphs 39-40).

As stated in paragraph 9, an advantage of making a camera available through a network is that multiple people can use a single camera. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's capture station devices accessible by a network.

Regarding **claim 11**, Bley discloses:

the one or more additional biometric capture devices include a signature capture device (signature digitizer pad 32; see column 3, lines 10-12, and column 4, lines 23-35).

Regarding **claim 12**, Bley discloses:

the one or more additional biometric capture devices include a fingerprint capture device (fingerprint digitizer pad 33; see column 3, lines 10-12, and column 4, lines 23-35).

Regarding **claim 13**, Bley discloses an all in one capture station for creating identification documents comprising:

a camera stand (system 10), the camera stand having a base (housing 40);

a camera (12) mounted within the tower;

a computer (processing module 11) integrated into the base of the camera stand; the computer including a processor (CPU 20), network interface device (interface port 26; see column 3, lines 2-5), and memory (RAM 21), the memory storing a camera control program (in order to carry out the steps described in column 4, lines 13-65, it is inherent that some sort of software is present) to capture data for incorporation into an identification document (see column 4, lines 41-67).

Bley is silent with regard to including a network interface program for transferring camera control commands and image data between the capture station and a remote workstation.

Fujino discloses a camera system, including:

a network interface program (inherently present, as it implements the TCP/IP protocol; see paragraph 31) for transferring camera control commands and image data between the capture station and a remote workstation such that the capture station operates under the control of the remote workstation (see paragraphs 36-39).

As stated in paragraph 9, an advantage of making a camera available through a network is that multiple people can use a single camera. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's capture station accessible by a network.

Bley is silent with regard to including a slidably attached tower. Official Notice is taken that it is well-known to have camera supports of adjustable height. An advantage of such a tower is that images may be captured of subjects of varying heights. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's system include a slidably attached tower.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bley in view of Fujino and further in view of Lin (U.S. Patent Application Publication No. 2004/0017490).

Claim 2 may be treated like claim 1. While Bley's system includes a lighting device (flash unit 52), he is silent with regard to the lighting device operating under control of the camera control program in the memory of the computer.

Lin discloses a network 30 (see Figure 2) with a control end 32, which is a computer (see paragraph 18). Control end 32 sends a flash signal to a computer (processors 16 and 18) in image capturing device 10 (see paragraph 19).

As stated in paragraph 19, an advantage of having a networked computer control a camera flash is that the computer can effect compensation when it receives an image with insufficient brightness. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's and Fujino's systems include a lighting device that operates under control of a camera control program.

7. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bley and Fujino and further in view of Abrahams (U.S. Patent No. 6,944,773).

Regarding **claim 4**, Bley discloses:

> a fingerprint capture interface device (fingerprint digitizer pad 33) and signature capture control program (process 100) in the memory for controlling a signature capture device that captures handwritten signatures (see column 3, lines 10-12, and column 4, lines 23-35).

However, Bley is silent with regard to having his device receive fingerprint capture control function requests from a remote workstation and send the fingerprint data to the remote workstation.

Abrahams discloses a fingerprint capturing method that works over a network. Server 104 requests (see column 4, lines 1-4) and stores (see column 5, lines 6-8) the fingerprints of a

new individual over network 102 (see column 3, lines 45-58) using fingerprint readers 120, 124, or 128 (see column 3, lines 30-35).

As stated in column 6, lines 50-56, an advantage of requesting and retrieving fingerprint data from a server is that a person may be identified remotely and stored in a central location for future use. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bley's system respond to a remote request for fingerprint data.

Claim 14 may be treated like claim 4.

Allowable Subject Matter

8. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No prior art could be located that teaches or fairly suggests an all-in-one capture station with a camera and computer and a remote workstation, wherein the station receives control function requests from the remote workstation via a network to control the capture of a signature.

Conclusion

9. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTW

JTW
August 29, 2006

VIVEK SRIVASTAVA
PRIMARY EXAMINER